

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application Number : 10/662,940 Confirmation No.: 2033
Applicant : Kimball C. Chen *et al*
Filed : September 16, 2003
Title : Electronic Message Delivery System Utilizable in the Monitoring and Control of Remote Equipment and Method of Same
TC/Art Unit : 3628
Examiner: : Igor N. Borissov
Docket No. : 64171.000002
Customer No. : 21967

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Pursuant to the Pre-Appeal Brief Conference Pilot Program announced in the Official Gazette, Applicants hereby request a pre-appeal brief conference in the above-referenced case.

This Application is appropriate for a pre-appeal brief conference. A brief history of this Application and why Applicants believe that an appeal will succeed are set forth below.

This Application was filed over five years ago on September 16, 2003.¹ On July 5, 2006, an initial office action on the merits was issued rejecting claims 1-3, 7, 8, 13, 15, 17, 19, 152, 180-182, 186, 187, 192, 194, 196, 198 and 331 under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter and rejecting claims 1-3, 7, 8, 13, 15, 17, 19, 152, 180-182, 186, 187, 192, 194, 196, 198 and 331 under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 5,544,036 to Brown, Jr. *et al* ("Brown") in view of U.S. Patent No. 6,178,362 to Woolard *et al* ("Woolard"). In the subsequent responses, Applicants had successfully overcome the 35 U.S.C. § 112, second paragraph rejection. However, despite additional attempts by Applicants in the subsequent responses to further clarify important distinctions of the present application, the Office has continued to maintain the same grounds of rejection using the same references. In the most recent rejection, a Non-Final Rejection ("Office Action") dated August 7, 2008, the Office

¹ The instant application claims priority to a provisional application filed January 9, 1999.

has again improperly rejected claims 1-3, 7, 8, 13, 15, 17, 19, 152, 180-182, 186, 187, 192, 194, 196, 198 and 331 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Brown in view of Woolard.

Despite clearly indicating the deficiencies in the proposed combination, the Office continues to misapply its obligation to show that all the claimed elements are taught by the references and provide a rationale for the combination under section 103. Specifically, the rejection is improper because Brown in combination with Woolard fail to teach all the claimed limitations for the claims rejected under 103.

Specifically referring to claims 1 and 180, the Office Action asserts that the claimed inventions would have been obvious in view of Brown and Woolard. Applicants respectfully disagree. In particular, Applicants submit that the combination of Brown and Woolard fails to disclose, or even suggest, a method and a system for controlling one or more of resource-consumption and resource-production associated with a plurality of remote devices, comprising: generating at least one informational message at a central server, where at least one information message is generated *automatically* “responsive to one or more of resource-consumption by, resource-production by, operating characteristics of, and operational state of at least one device of the plurality of remote devices,” as presently claimed. In contrast, Brown merely discloses that utility command center computer 24 provides paging signals to transmitter 20 which provides appropriate paging messages to the controllers 14. *See, e.g.*, Brown at 4:7-10. At best, Brown discloses a one way communication channel for sending paging signals from transmitter 20 to controllers 14. *See, e.g.*, Brown Figure 1. The paging signals of Brown are not automatically generated “responsive to one or more of resource-consumption by, resource-production by, operating characteristics of, and operational state at least one device of the plurality of remote devices,” as presently claimed. Therefore, Applicants respectfully submit that Brown fails to disclose, or even suggest, the claimed automatic recursive feature. In addition, Woolard fails to make up this clear deficiency.

Moreover, the Office Action asserts that Brown discloses a computer and the “automatic” feature would be obvious since it has been held that broadly providing a mechanical or automatic means to replace manual activity which has accomplished the same result involves only routine skill in the art. Applicants respectfully disagree. Applicants respectfully submit that the Office Action fails to provide a basis in fact and/or technical reasoning to reasonably support the determination that the “automatic” feature would have been obvious necessarily flows from the

teaching of using a computer, as taught by Brown. The mere fact that Brown discloses a computer is not sufficient to establish *automatically* generating at least one information message “*responsive to* one or more of resource-consumption by, resource-production by, operating characteristics of, and operational state at least one device of the plurality of remote devices.”

Applicants respectfully submit that one of ordinary skill in the art at the time of the invention would not have combined Brown and Woolard and that the Office’s conclusion is clearly based on **improper hindsight** reasoning. Accordingly, the Office has failed to set forth a *prima facie* case of obviousness.

Regarding claims 2, 3, 7, 8, 13, 15, 17, 19, 152, 181, 182, 186, 187, 192, 194, 196, 198 and 331 these claims are dependent upon independent claims 1 and 180. Thus, since independent claims 1 and 180 should be allowable as discussed above, claims 2, 3, 7, 8, 13, 15, 17, 19, 152, 181, 182, 186, 187, 192, 194, 196, 198 and 331 should also be allowable at least by virtue of their dependency on independent claims 1 and 180. Moreover, these claims recite additional features which are not disclosed, or even suggested, by the cited references taken either alone or in combination.

For example, dependent claim 3 recites “receiving at least one command at the central server, wherein the at least one command is related to controlling the at least one device and wherein the at least one informational message is generated based on the at least one command.” Dependent claim 182 recites a similar limitation. Recognizing the deficiencies in Brown, the Office Action relies on Woolard. Woolard purports to disclose the ability to diagnose energy usage problems and develop strategies to reduce energy costs by optimizing responses to queries by the user based on the time of day, the current energy rate and environmental conditions. *See, e.g.,* Woolard at 4:47-51. There is nothing in Woolard that provides any teaching or suggestion that an information message is generated based on the at least one command. Accordingly, the Office Action has failed to show how Woolard teaches “receiving at least one command at the central server” and further where “the at least one command is related to controlling at least one device and wherein the at least one informational message is generated based on the at least one command.” These claim features are simply missing from the disclosure of Woolard.

Furthermore, dependent claim 13 recites “wherein the at least one command is generated in accordance with a user profile.” Dependent claim 192 recites a similar limitation. Dependent claims 14 and 194 depend on claims 13 and 192, respectively. Dependent claim 152 recites that “wherein the at least one command is from a user associated with the at least one device, the user

having an associated user profile.” Dependent claim 331 recites a similar limitation. Recognizing the deficiencies in Brown, the Office Action relies on Woolard. Specifically, the Office Action asserts that Woolard teaches that user can customize, create or update a particular site to add various information thereby suggesting the “profile” feature. Applicants respectfully disagree. In contrast, Woolard merely appears to suggest that facility navigator 42 permits the user of the energy and facility manage apparatus 26 to view real-time two-dimensional or three-dimensional representations of any facility in the physical plant, to configure a particular site. *See, e.g.*, Woolard at 6:23-28. The Office Action has failed to show how this disclosure meets the limitation of “a user profile” and further where “the at least one command is generated in accordance with a user profile.” The disclosure relied upon by the Office Action for meeting the “at least one command” limitation and the “user profile” limitations are unrelated. Therefore, it is clear that Woolard fails to show “wherein the at least one command is generated in accordance with a user profile.” The claim limitations directed to a user profile are simply missing from the disclosure of Woolard.

In view of the foregoing, it is respectfully requested that the aforementioned obviousness rejection of claims 1-3, 7, 8, 13, 15, 17, 19, 152, 180-182, 186, 187, 192, 194, 196, 198 and 331 be withdrawn.

II. Conclusion

Thus, in view of the foregoing, an appeal on that basis will certainly succeed, but the time and expense in preparing an appeal brief on that issue should not be borne by Applicants when the grounds are so clearly improper.

Respectfully submitted,

Date: **November 7, 2008**

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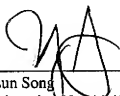
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